

ay



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,287	11/22/2000	Peter Joseph Marsico	1322/62	2195
25297	7590	11/29/2005	EXAMINER	
JENKINS, WILSON & TAYLOR, P. A. 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707			BORISSOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/721,287	<b>Applicant(s)</b> MARSICO ET AL.	
	<b>Examiner</b> Igor Borissov	<b>Art Unit</b> 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 10-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 10-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## DETAILED ACTION

### *Response to Amendment*

Amendment received on 8/26/2005 is acknowledged and entered. Claims 2, 8 and 9 have previously been canceled. Claims 1, 3-7, 15, 18-21, 25-28, 30, 34-36, 38, 40, 45 and 46 have been amended. New claims 46-50 have been added. Claims 1, 3-7 and 10-50 are currently pending in the application.

Claim Rejections under 35 USC § 112 and Claim Rejections under 35 USC § 101 have been withdrawn.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4, 6, 7, 10-14, 17-18, 20-24, 26, 27, 29-33, 37-42, 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee et al. (US 6,449,474).**

Mukherjee et al. (Mukherjee) teaches a computer implemented method and system for providing call interception, comprising:

#### *Independent Claims.*

**Claims 1, 26 and 46.** Receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired (intercepting the call)

Art Unit: 3639

(a complaint registration application) (C. 6, L. 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, automatically generating call intercept information/message, connecting to a law enforcing agency computer over a network using TCP/IP protocol, and transmitting said information/message to law enforcing agency (C. 6, L. 14-26).

While Mukherjee teaches generating information/message regarding unwanted call and communicating said information/message to the law enforcing agency, Mukherjee does not explicitly teach that said message is a complaint registration message.

However, the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, because it would advantageously allow to catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

**Claims 20 and 50.** Receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired (C. 6, L. 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, automatically generating call intercept information/message, connecting to a law enforcing agency computer over a network using TCP/IP protocol, and transmitting said information/message to law enforcing agency (C. 6, L. 14-26).

While Mukherjee teaches generating information/message regarding unwanted call and communicating said information/message to the law enforcing agency,

Art Unit: 3639

Mukherjee does not explicitly teach that said message is a complaint registration message.

However, the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, because it would advantageously allow to catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

Also, Mukherjee does not specifically teach that said determining step includes determining whether said communication initiator has previously been notified not to initiate communication.

However, Mukherjee teaches that it is difficult to track or intercept unwanted call initiators, which allows a malicious call initiators to allude monitoring agencies (C. 1, L. 64-67), which, in turn, indicates a repetitive character of said unwanted calls, including making repetitive calls using the same number, and been asked by disturbed subscribers of said numbers not to call again.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to further modify Mukherjee to include that said determining step includes determining whether said communication initiator has previously been notified not to initiate communication, because it would advantageously allow to prevent unwanted calls from all type of unwanted callers, including those who was previously notified, and who was not.

#### Dependent Claims

**Claim 4.** See reasoning applied to claim 1.

**Claim 6.** Said method wherein said parameter is telephone number of the initiator (C. 5, L. 55).

Art Unit: 3639

**Claim 7.** Said method wherein said parameter is mobile telephone number of the initiator (C. 5, L. 55).

**Claims 10-11.** Same reasoning as applied to claim 20.

**Claim 12.** Transmitting said information/message to law enforcing (C. 6, L. 23-26).

**Claim 13.** Transmitting said information/message to one of designated law enforcing agency (C. 6, L. 23-26; C. 7, L. 44-45).

**Claim 14.** Transmitting said information/message to law enforcing (government) agency (C. 6, L. 23-26).

**Claims 17-18, 23-24, 27 and 30.** Providing communication in TCP/IP protocol environment indicates use of SIP protocol.

**Claims 21, 22, 40 and 42.** See reasoning applied to claim 20.

**Claim 29.** See reasoning applied to claim 26.

**Claim 31.** See reasoning applied to claim 1.

**Claim 32.** Said server is adapted to send said message to a law enforcing agency (third party) (C. 6, L. 23-26).

**Claim 33.** Said server is adapted to send said message to a law enforcing (government) agency (C. 6, L. 23-26).

**Claim 37 and 41.** Providing communication in TCP/IP protocol (C. 6, L. 23-26).

**Claim 38.** See reasoning applied to claim 1.

**Claim 39.** Providing communication in TCP/IP protocol (C. 6, L. 23-26).

**Claim 44.** See reasoning applied to claim 1.

**Claims 47, 48 and 49.** Said system wherein said information/message is generated by the message generating means (the complaint message generator) (C. 6, L. 14-26). Information as to "the complaint message generator is local to the a complaint registration application" is given no patentable weight, because the method steps disclosed by Mukherjee would be performed the same regardless whether the complaint message generator is local to the a complaint registration application, or not.

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Pinder et al. (US 6,701,160).**

*Dependent Claim.*

**Claim 3.** Mukherjee teaches all the limitations of claim 3, except specifically teaching that said communication is a short message service message.

Pinder et al. (Pinder) teaches a method and system for locally blocking incoming selected calls, wherein said incoming calls are short message service messages (C. 1, L. 65 – C. 2, L. 1).

It would have been obvious to one having ordinary skill in the art to modify Mukherjee to include that said communication is a short message service message, as disclosed in Pinder, because it would advantageously increase the application field of the system, thereby increase revenue.

**Claims 5, 28, 34-36, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Correia, II (US 5,926,534).**

*Independent Claim.*

**Claim 45.** Mukheree teaches said system including a computer-readable medium including instruction to execute a method, comprising: receiving an incoming call signaling message from a communication initiator (C. 6, L. 6-10); identifying (extracting a parameter) from the call signaling message and determining whether the communication is from a communication initiator with whom communication is not desired by performing a lookup in a table (C. 6, L. 1-5, 10-22); in response to determining that the communication is from a communication initiator with whom communication is not desired, automatically generating call intercept information/message, connecting to a law enforcing agency computer over a network using TCP/IP protocol, and transmitting said information/message to law enforcing agency (C. 6, L. 14-26).

Art Unit: 3639

While Mukherjee teaches generating information/message regarding unwanted call and communicating said information/message to the law enforcing agency, Mukherjee does not explicitly teach that said message is a complaint registration message.

However, the effect achieved by generating and transmitting of said information/message is the same as if said message would be a complaint registration message.

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said generated and transmitted to the law enforcement agency information/message is a complaint registration message, because it would advantageously allow to catch malicious callers which otherwise allude monitoring agencies (Mukherjee, C. 1, L. 66-67).

Also, Mukherjee does not specifically teach that said compliant registration message is generated *upon detecting that a manual trigger has been generated by the user* communication terminal during said communication.

Correia, II (Correia) teaches a method for blocking unwanted calls for a computer system, including comparing an incoming call phone number with a list of authorized phone numbers, and blocking said call if said incoming call phone number does not match with said list, wherein said call is a facsimile message (C. 2, L. 25-28), wherein said system is incorporated into a personal computer (C. 4, L. 50-51), thereby indicating user interaction with said personal computer.

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include generating said compliant registration message upon detecting user interaction with said personal computer during said communication, as disclosed in Correia, because it would advantageously allow user to adjust the system to any unexpected calls.

**Dependent Claims.**

**Claim 5.** Mukherjee teaches all the limitations of claim 5, except specifically teaching that said communication is a facsimile message.



Correia teaches a method for blocking unwanted calls for a computer system, including comparing an incoming call phone number with a list of authorized phone numbers, and blocking said call if said incoming call phone number does not match with said list, wherein said call is a facsimile message (C. 2, L. 25-28).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee to include that said communication is a facsimile message, as disclosed in Correia, because it would advantageously increase the application field for the system, thereby increase revenue.

**Claim 28.** Correia teaches that the communication terminal is a personal computer (C. 4, L. 50-51). The motivation to combine Mukherjee with Correia would be to advantageously increase the application field for the system, thereby increase revenue.

**Claim 34.** Correia teaches that the communication terminal is a personal computer (C. 4, L. 50-51), thereby indicating a user interaction. The motivation to combine Mukherjee with Correia would be to advantageously increase the application field for the system, thereby increase revenue.

**Claim 35.** Correia teaches said personal computer (terminal) includes a call blocking database (C. 3, L. 38-40).

**Claim 36.** See reasoning applied to claim 20.

**Claim 43.** Correia teaches that said *blocking* functionality is incorporated into a modem (C. 4, L. 49-67). Official Notice is taken that it is well known to incorporate a modem into a computer. Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Mukherjee and Correia to include that said *blocking* functionality is incorporated into a computer (communications terminal), because it would advantageously simplify the use of the system and decrease operation cost by scaling it down to be used by a single person.

**Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view Ardon (US 5,751,800).**

Dependent Claims.

**Claim 15.** Murkherjee teaches all limitations of claim 15, except specifically teaching *in response to receiving the call signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted.*

Ardon teaches a method and system for screening of incoming calls prior to call completion, wherein, upon receiving unwanted call, a message that this call are not accepted is send to the call initiator (C. 3, L. 15-19).

It would have been obvious to one having ordinary skill in art the time the invention was made to modify Murkherjee to include notifying the communication initiator that these calls are not accepted in response to receiving the call signaling message from the communication initiator, as disclosed in Ardon, because by warning the call initiators of undesirability of his action, it would advantageously allow said caller to avoid possible future interaction with a law enforcing agency.

In response to receiving the call signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted (column 3, lines 15-19).

**Claim 16.** Murkherjee and Ardon teach all the limitations of claim 16, including in response to receiving the call-signaling message from the communication initiator, notifying the communication initiator that these calls are not accepted (Ardon; C. 3, L. 15-19).

However, Murkherjee and Ardon do not specifically teach that notifying the communication initiator includes notifying that the complaint registration message is being sent to a complaint registration database.

Official notice is taken that it is well known to warn unwanted telemarketers (communication initiators) that further calls would result in a complaint to an appropriate authority. It is also well known that to pursue the legal action against unwanted contacts, one has to prove that the unwanted entity has been warned that said contacts are unwanted.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Murkherjee and Ardon to include notifying

Art Unit: 3639

the communication initiator that the complaint registration message is being sent to a complaint registration database, because it would prevent the communication initiator from calling to the recipient again.

**Claims 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mukherjee in view of Almgren et al. (US 6,668,175).**

*Dependent Claims.*

**Claims 19 and 25.** Mukherjee teaches all the limitations of claims 19 and 25, except specifically teaching that extracting parameter from the signaling message includes extracting a parameter *from the From field of the invite message*.

Almgren et al. (Almgren) teaches a method and system for providing rules-defined communication services, including blocking calls, using session initiation protocol, wherein the session is identified and characterized by means of the packet headers (encapsulating the message), from which various parameters, including identification data, can be extracted (C. 8, L. 12-25).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mukherjee to include extracting identifying data from the invite message, as disclosed in Almgren, because it would advantageously allow to keep track of sources of incoming messages, thereby helping law enforcement agencies to identify most active suspects.

***Response to Arguments***

Applicant's arguments with respect to Claims 1, 3-7 and 10-50 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Art Unit: 3639

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 703-305-4649. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor Borissov  
Patent Examiner  
Art Unit 3639

A handwritten signature in black ink, appearing to read 'Igor Borissov', with a large, stylized loop at the end.

IB

11/25/2005